

**REMARKS**

**INTRODUCTION:**

In accordance with the foregoing, claims 1-15, 17, 20, 22, 24, 26, 29-31, 33, 35-37, 39, 41, 45, 47-49, 51, 56, 58, 59, 61, 64, 66, 70, 72, 73-75, 78 and 79 have been amended, and new claims 80-109 have been added. Support for the amendments and the new claims may be found at least at paragraph [0019], [0020] [0025], [0027], [0028], [0029], [0030], [0034], [0046], and [0047] of the above-identified application and therefore no new matter has been presented.

Claims 1-109 are pending in the present application. Claims 1, 13, 20, 30, 41, 49, 64 and 100 are independent claims. Applicant requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

**REJECTION UNDER 35 U.S.C. §101:**

Claims 78 and 79 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. This rejection is traversed and reconsideration is requested.

The claims have been amended to address the rejection and to clarify the recitations. Accordingly, it is respectfully requested the rejection of claims 78 and 79 be withdrawn.

**REJECTIONS UNDER 35 USC 102 AND 103:**

Claims 20 and 41 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,904,406 B2 (Yamaji). Claims 1-4, 6-12, 13-18, 30-37, 39, 40, 45, 48-56, 59-70, and 73-77 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2003/0192058 A1 (Miyatake). Claims 5, 19, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyatake in view of U.S. Patent No. 7,030,930 B2 (Kovacevic). Claims 21-27, 29, 42-44, and 79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamaji in view of Miyatake. Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamaji in view of Miyatake, and further In view of Kovacevic. Claims 46, 47, 57, 58, 71, 72, and 78 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyatake in view of Yamaji. All rejections are respectfully traversed.

Amended independent claim 20 recites at least the following:

a controller that

“if the user requires the storage, controls the compression and decompression unit in the compression mode and stores the compressed digital video signal and/or audio signal compressed by the compression and decompression unit in the external storage medium in real time”

Yamaji, Miyatake and Kovacevic taken separately or in combination, fail to suggest or disclose at least the above-recited features of amended independent claim 20.

Yamaji is directed to an audio playback and recording apparatus. However, Yamaji fails to even mention the term “video,” let alone describe all of the above-recited features. Accordingly, at least the above-claimed features are patentable over Yamaji.

Miyatake is directed to an apparatus and method for retrieving a video at high speed using a feature of the video as a clue, in lieu of a keyword (par. [0001]). However, Miyatake fails to suggest or disclose a controller that “stores the compressed digital video signal and audio signal compressed by the compression and decompression unit in the external storage medium in real time.” Moreover, the Office Action fails to specifically set forth if and where each of the above-claimed features, e.g., a compression and decompression unit, are disclosed in Miyatake. If any future rejection based on Miyatake is to be asserted, Applicant respectfully requests the Office Action provide a specific paragraph number and figure reference, or specifically indicate if an assertion of inherency is being relied upon.

Kovacevic is directed to a system for synchronizing the output of decoded audio data to the presentation of decoded video data (col. 2, lines 1-3). In Kovacevic audio data is transferred to memory and then the stored audio data is read from memory after a delay period, allowing the decoded audio and video data to be output synchronously (col. 2, line 60 – col. 3, line 8). Kovacevic fails to even mention “real time” storing of data, let alone all of the above-recited features.

Accordingly, Applicant respectfully submits that amended independent claim 20 patentably distinguishes over the combination of Yamaji, Miyatake and Kovacevic, and should be allowable for at least the above-mentioned reasons. Since similar features recited by each of the independent claims 13 and 41, with potentially differing scope and breadth, are not taught

or disclosed by Yamaji, Miyatake and Kovacevic, the rejection should be withdrawn and claims 13 and 41 also allowed.

Further, Applicant respectfully submits that claims 14-19, 21-29, 42-48 and 79, which variously depend from independent claims 13, 20 and 41, should be allowable for at least the same reasons as claims 13, 20 and 41, as well as for the additional features recited therein.

Amended independent claim 1 recites at least the following:

“A display apparatus capable of being connected to an external storage medium disposed external to the display apparatus, the display apparatus comprising:

a receiving processor that receives a digital video signal and/or an audio signal;

a controller that, if a user commands storage of the received digital video signal and/or audio signal, stores the received digital video signal and/or audio signal in the external storage medium; and

a port disposed on the display apparatus, through which the received digital video signal and/or audio signal are transmitted from the display apparatus to the external storage medium.”

Yamaji, Miyatake and Kovacevic taken separately or in combination, fail to suggest or disclose at least the above-recited features of amended independent claim 1.

The Office Action notes on page 15 that Yamaji fails to disclose all of the features of claim 1. However, the Office Action proposes to modify Yamaji with Miyatake, and asserts that Miyatake compensates for the deficiencies of Yamaji. Applicant respectfully disagrees for at least the following reasons.

Miyatake sets forth a video retrieval apparatus including a computer 2 located between a display 1 and an external information storage device 12 (see, for example, FIG. 1). Although the display 1 can display a video signal read from the external information storage device through the computer 2, the video retrieval system illustrated in FIG. 1 of Miyatake does not include “a receiving processor,” “a controller,” or “a port disposed on the display apparatus” as in the above-recited claim. Moreover, the display 2 of Miyatake is connected to the computer 2, rather than being directly connected to the external information storage device 12. Accordingly, Miyatake fails to suggest or disclose all of the features recited in claim 1.

Kovacevic fails to compensate for the deficiencies of Yamaji and Miyatake.

Accordingly, Applicant respectfully submits that amended independent claim 1 patentably distinguishes over the combination of Yamaji, Miyatake and Kovacevic, and should be allowable for at least the above-mentioned reasons. Further, Applicant respectfully submits that claims 2-12, which depend from independent claim 1, should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

Amended independent claim 30 recites at least the following:

“A method of operating a display apparatus configured to be capable of being directly connected to an external storage medium disposed external to the display apparatus”

Yamaji, Miyatake and Kovacevic taken separately or in combination, fail to suggest or disclose at least the above-recited features of amended independent claim 30.

The Office Action asserts on page 4 that Miyatake describes all of the features of claim 30. Applicant respectfully disagrees for at least the following reasons.

As a matter of law, when an Applicant uses the body of a claim and the preamble to define the claimed subject matter, the preamble should be accorded patentable weight. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). MPEP § 2112.02 (I) further instructs that preambles that limit structure must be given patentable weight. Here, the preamble of claim 30 limits the method being performed to a display apparatus having a particular structure, as recited above. Consequently, the preamble of claim 30 should be afforded patentable weight.

Miyatake is directed to a video retrieval apparatus including a computer 2 located between a display 1 and an external information storage device 12 (see FIG. 1). However, the display 2 of Miyatake is connected to the computer 2 rather than being connected to the external information storage device 12, as in the above-recited preamble. Accordingly, Miyatake fails to suggest or disclose all of the features recited in claim 30.

Kovacevic and Yamaji, alone or in combination, fail to compensate for the deficiencies of Miyatake.

Accordingly, Applicant respectfully submits that amended independent claim 30 patentably distinguishes over the combination of Yamaji, Miyatake and Kovacevic, and should be allowable for at least the above-mentioned reasons. Further, Applicant respectfully submits

that claims 31-40, which depend from independent claim 30, should be allowable for at least the same reasons as claim 30, as well as for the additional features recited therein.

Amended independent claim 49 recites at least the following:

“A reproducing apparatus connected with a storage medium disposed external to the reproducing apparatus”

Yamaji, Miyatake and Kovacevic taken separately or in combination, fail to suggest or disclose at least the above-recited features of amended independent claim 1.

Applicant asserts that the recited preamble of claim 49 must be given patentable weight because it limits the structure of the claim to “reproducing apparatus connected with a storage medium disposed external to the reproducing apparatus.” In contrast, the video reproducing device 5 of Miyatake is connected to the computer 2, but is not directly connected to the external information storage device. Accordingly, the video reproducing device 5 of Miyatake can only transmit a video signal to the external information storage device through computer 2. Accordingly, Miyatake fails to suggest or disclose all of the features recited in claim 1.

Kovacevic and Yamaji, alone or in combination, fail to compensate for the deficiencies of Miyatake.

Accordingly, Applicant respectfully submits that amended independent claim 49 patentably distinguishes over the combination of Yamaji, Miyatake and Kovacevic, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claim 64, with potentially differing scope and breadth, are not taught or disclosed by Yamaji, Miyatake and Kovacevic, the rejection should be withdrawn and claim 64 also allowed.

Further, Applicant respectfully submits that claims 50-63 and 65-74, which variously depend from independent claims 49 and 64, should be allowable for at least the same reasons as claims 49 and 64, as well as for the additional features recited therein.

#### NEW CLAIMS:

New independent claim 100, and dependent claims 80-99 and 101-109, each having additional patentable features have been added. Consideration of the new claims is respectfully requested.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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